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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,575	10/28/2003	Steven R. Eichenbaum	4526-107 US	5353
7590	08/03/2005			
Diane Dunn McKay, Esq. Mathews, Collins, Shepherd & McKay, P.A. Suite 306 100 Thanet Circle Princeton, NJ 08540			EXAMINER FIDEI, DAVID	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Tata

Office Action Summary	Application No.	Applicant(s)	
	10/695,575	EICHENBAUM, STEVEN R.	
	Examiner	Art Unit	
	David T. Fidei	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 19-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/23/04</u> . | 6) <input type="checkbox"/> Other: ____. |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to system, classified in class 206.
 - II. Claims 19-25, drawn to a method, classified in class 53.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product reciting the case a formed by ultrasonically welding defines no distinguishing structure over the article per se and is viewed as an non-limiting product by process limitation. In the instant case the product as claimed can be made by a materially different process such as thermally or adhesively sealing the top and bottom of the case.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Diane Dunn McKay on July 11, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-18. Applicant in replying to this Office action must make affirmation of this election. Claims 19-25 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 10 and 15-18 rejected under 35 U.S.C. 102(b) as being anticipated by Photograde. Page 28 shows the end of a typical grading process where the photo's show a coin placed in a core which is encased in what is termed a "slab". Once the grade of a coin is established, the numerical destination is printed on a ticket which is enclosed with the coin in a plastic encasement popularly known as the slab. Sonically sealed, the slab protects the coin from further handling ensuring that it will remain in the graded state, see the second paragraph of page 28. Hence, the ticket is equivalent the means for authenticating the coin and the sonic sealing is the means for positively indicating sealing of the top to the bottom as is claimed and disclosed. As to the system disclosed by Photograde, the core receiving the peace dollar shown in the figure is "adapted for receiving a plurality of coins" in as much as is claimed. The core is adapted for receiving a plurality of coins in that different mintage peace dollars of varying grades can be placed in the core. Also, the core is adapted for receiving a plurality of coins in that different dollar series, e.g., Morgan or Eisenhower, can be placed in the core. The system shown in the large photograph with the man completing the certification process is also adapted for receiving a plurality of coins.

As to claims 10 and 15, in order to distinguish over the prior art there must be some functional relationship between the specific content of the printed matter to the apparatus employing the printed matter, i.e., the printed matter depends on the apparatus, and the apparatus depends on the printed matter. Although factually distinct, the *In re Ngai*, 70 USPQ2d 1862 (Fed. Cir. 2004) and *In re Gulack*, 217 USPQ 410 (Fed. Cir. 1983), held the same basic premise of "where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. In the present case the

printed matter on the certificate, or hologram, is not related to the “slab” but relates to the coins placed therein.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Photograde in view of Levy (Patent no. 2,985,284). As noted above Photograde Page 28 shows the end of a typical grading process where the photo's show a coin placed in a core which is encased in what is termed a “slab”. Once the grade of a coin is established, the numerical destination is printed on a ticket which is enclosed with the coin in a plastic encasement popularly known as the slab. Sonically sealed, the slab protects the coin from further handling ensuring that it will remain in the graded state, see the second paragraph of page 28. Hence, the ticket is equivalent the means for authenticating the coin and the sonic sealing is the means for positively indicating sealing of the top to the bottom as is claimed and disclosed. The difference between the claimed subject matter and Photograde resides in the core comprising a substrate having a plurality of openings therein, note claim 2.

Levy discloses that it is notoriously well known to construct inserts for coin holding plastic boxes having a plurality of openings, see figure 1. It would have been obvious to one of ordinary skill in the art to modify the slab shown in the grading process of Photograde by constructing the core comprising a substrate having a plurality of openings as suggested by Levy, in order to enable collecting of all the coins of a particular year or mintage.

As to claims 3, 4, 5, 7 and 8, a gasket 52 is disclosed in the form of rings inserted in the openings. The equivalent gasket 52 or Levy et al is disclosed as being made of the same material as the block 30' which is not disclosed. However an cellulose acetate material is disclosed for block 30, see col. 2, lines 22, 23. As to claims 6 and 9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ any conventional material for the gaskets such as EVA, rubber or a styrene butadiene copolymer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, see § M.P.E.P. 2144.06.

As to claim 11, the book reference Photograde does not disclosed if the ticket serving as the certificate is affixed with a pressure sensitive adhesive. However, Official Notice is taken for the use of pressure sensitive adhesives in affixing labels or other indicia carrier members to containers, sheets or articles. It would have been obvious and well within the level of ordinary skill in the art to employ a pressure sensitive adhesive on the bottom surface of the Photograde certificate in view of Official Notice, in order to provide a fixed attachment of the ticket so that remains in place and does not move.

As to claims 12-15, printed matter on the certificate, or hologram, is not related to the structure feature of the apparatus but relates to that of coins placed therein. Such printed matter is of no patentable distinction, see 5 above. Even if the printed matter had some interactive relationship related to the substrate upon which it is placed, information pertaining to the grade of the coin is well indicia in this art. To provide coins and indicia the same, or different, grades would have been an obvious matter of design choice, for the reason that this parameter is purely dependent upon the coins one desires to encase. Providing holograms as a means for certifying a product is also old and well known.

As to claims 16-18, the system of Photograde uses cases of plastic and the means for sealing is considered equivalent that recited in claim 18. If the applicant disagrees with the inference of equivalence drawn from a prior art reference, the applicant may provide reasons why the applicant believes the prior art element should not be considered an equivalent to the specific structure, material or acts disclosed in the specification. Such reasons may include, but are not limited to: 1) teachings in the specification that particular prior art is not equivalent, 2)

teachings in the prior art reference itself that may tend to show non-equivalence, or 3) Rule 132 affidavit evidence of facts tending to show non-equivalence. Moreover, if an applicant argues that the "means" or "step" plus function language in a claim is limited to certain specific structural or additional functional characteristics (as opposed to "equivalents" thereof) where the specification does not describe the invention as being only those specific characteristics, the claim should be not allowed until the claim is amended to recite those specific structural or additional functional characteristics (emphasis added). See 1162 OG 61, May 17, 1994.

Drawings

8. The drawings are objected to under 37 CFR 1.83(a) because they are burly (note figures 1 and 2) and fail to show the details as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

9. The abstract of the disclosure is objected to because of the use of legal phraseology such as "means". Correction is required. See MPEP § 608.01(b).

10. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

REPLY BY APPLICANT OR PATENT OWNER TO THIS OFFICE ACTION

11. "In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to every ground of objection and rejection in this Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

The reply must be reduced to writing (emphasis added)", see 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.

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Pointing out specific distinctions means clearly indicating in the written response what features/elements or distinctions have been added to the claim/claims, where support is found in the specification for such recitations and how these features are not shown, taught, obvious or inherent in the prior art.

If no amendments are made to claims as applicant or patent owner believes the claims are patentable without further modification, the reply must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office Action in the same vain as given above, 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.


The examiner also points out, due to the change in practice as affecting final rejections, older decisions on questions of prematureness of final rejection or admission of subsequent amendments do not necessarily reflect present practice. "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)" (emphasis mine), see MPEP 706.07(a).

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David T. Fider
Primary Examiner
Art Unit 3728

dtf
July 22, 2005